



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/773,679

02/06/2004

Gordon Plotkin

977-6

7511

7590 05/28/2008  
THE MARTINEZ GROUP PLLC  
Mark Sgantzios  
55 Poplar Street  
Suite 1-D  
Brooklyn, NY 11201-6930

EXAMINER

ABDELSALAM, FATHI K

ART UNIT

PAPER NUMBER

4176

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,679	<b>Applicant(s)</b> PLOTKIN ET AL.	
	<b>Examiner</b> Fathi Abdelsalam	<b>Art Unit</b> 4176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040206</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

1. This action is in response to applicant's communication filed on 06/11/2004, wherein claims 1-6 are currently pending.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 02/06/2004 is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-6 are rejected under 35 U.S.C. §101 because the claims are considered hybrid claims ("system and method"). See MPEP §2173.05(p) II.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Wake (US 4,796,201).

7. Regarding **Claim 1**:

Wake discloses a method of managing the development of a packaging prototype ([Abstract], "Stored program controlled data processing apparatus operates in concert with display and printing equipment to create, modify and print graphics for consumer goods or other packaging applications") and ([Col. 1, lines 5-10], "packaging designs and, more specifically, to a stored program controlled system for creating, viewing, modifying and printing graphics-bearing packaging materials"), comprising:

providing a packaging prototype system whereby said system dictates how the packaging for a product will be produced based on a production process between a design manager and suppliers ([Col. 2, lines 26-31], "as a first matter, the processing of the instant invention permits a designer to originate and modify graphics until satisfied with the esthetics and accuracy of the composite graphics presentation which will

ultimately be printed on the packaging”), whereby a communications platform is established between the design manager and the suppliers (see Abstract lines 18-21).

8. Regarding **Claims 2-3**:

Wake discloses a method of managing the development of a packaging prototype wherein the communications platform being established between the design manager ([Col. 2, lines 26-31], “as a first matter, the processing of the instant invention permits a designer to originate and modify graphics until satisfied with the esthetics and accuracy of the composite graphics presentation which will ultimately be printed on the packaging”); and

said suppliers, the suppliers consisting of a separator ([Col. 2, lines 34-36], “In the initial formation of an image, the operator/graphics creator enters each constituent (“element”) of the ultimate image and defines its parameters”);

a designer ([Col. 2, lines 46-49], “As additions, modifications or deletions are being made to one or more image elements, the effect is presented to the designer on the face of the display”); and

a printer ([Col. 3, lines 7-10], “Once the packaging design is in final form, it is communicated from memory to any per se well known printing device for reproduction as desired to satisfy the packaging requirement”); and

wherein providing the packaging prototype system, said communications platform comprises a protocol, a production planned prototype ([Col. 3, lines 7-10],

“once the packaging design is in final form, it is communicated from memory to any per se well known printing device for reproduction as desired”; and

a plan ([Col. 1, lines 25-28], “packaging development apparatus which assigns priorities to packaging design elements”).

9. Regarding **Claim 4**:

Wake discloses a method of managing the development of a packaging prototype wherein providing the packaging prototype system protocol involves understanding objectives, providing a baseline expertise, exploring production opportunities and identifying obstacles in the production process (Col. 1, lines 17-29).

10. Regarding **Claim 5**:

Wake discloses a method of managing the development of a packaging prototype wherein providing the packaging prototype system and the production planned prototype involves emulating a specific print process chosen for final production whereby the final production print process is replicable ([Col. 3, lines 7-10], “Once the packaging design is in final form, it is communicated from memory to any per se well known printing device for reproduction as desired to satisfy the packaging requirement.”)

11. Regarding **Claim 6**:

Wake discloses a method of managing the development of a packaging prototype wherein providing the packaging prototype system plan contains a print sample, black and white progressives, production specifications, product package in final print form (Col. 3, lines 7-10);

key information learned during the creation of the prototype ([Col. 6, lines 66-67], “store the changed information”);

color swatches and digital support files whereby the plan provides documentation to replicate the packaging prototype and said package in final print form ([Col. 3, lines 7-10], “Once the packaging design is in final form, it is communicated from memory to any per se well known printing device for reproduction as desired to satisfy the packaging requirement”).

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fathi Abdelsalam whose telephone number is (571) 270-3517. The examiner can normally be reached Monday to Thursday 8:00-5:00 ET.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A./  
Examiner, Art Unit 4176  
May 13, 2008

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 4176